

REMARKS

Undersigned counsel gratefully acknowledges the interview held with the inventor, Dr. Alleman, Examiner Matar, and S.P.E. Zele on November 4, 1997. An interview summary form was not provided after the long interview, and it has not been received to date from the Office, so applicant will here attempt to summarize the interview. The issues raised in the Office Action, paper number 16, were discussed. A draft declaration of Dr. Alleman was presented informally before the interview, in which a previously submitted Rule 131 declaration was discussed. Most of the interview was directed to perceived inconsistencies between the Rule 131 declaration submitted in this case as compared to the Rule 131 declaration submitted in the parent case, which has been before the Board of Appeals for the past two years.

Examiner Matar put up a timeline derived from the 131 declaration in the parent case, and he stated that the 131 declaration in this case was confusing because it did not have exactly the same events described as in the parent case. For purposes of overcoming the references to the New York Times article of January 9, 1992, Business Week article dated April 13, 1992, and Business Week article dated December 2, 1991, cited at pages 11-13 of the Action, it makes no difference whether the Rule 131 declaration in the parent case is relied upon or the one submitted in this case, since each one overcomes the references by sworn testimony of the inventor showing at least as much structure as the references show.

However, because Examiner challenged the 131 declaration in this case as not being truthful, applicant has reconsidered the declaration submitted in this case, and



withdraws the claim of overcoming based on Rule 131, leaving that issue to be determined in the parent case by the Board. This is not to concede that the references are prior art. Rather, it is simply an attempt to narrow the issues in this case to try to advance the prosecution towards allowance.

Examiner Zele made a constructive suggestion at the interview, suggesting that applicant's argument in this case should be directed to the merits of the cited references, rather than seeking to overcome them under Rule 131. This Response is intended to pursue this suggestion, leaving the 131 issue for determination by the Board in the parent case.

On the merits, none of the three articles cited in paragraph 6 of paper 16 has any mention of Direct Inward Dialing (DID). Examiner Matar stated that the reference to the New York Times article at page 4 of the specification in this case constituted an admission that the article disclosed DID, because the use of DID was "inherent" in the article. As pointed out in paragraph 11 of the attached declaration of Dr. Alleman under Rule 132, page 4 of the specification states that the New York Times article "suffers the disadvantage of requiring input telephone trunks dedicated to specific users." Dedicated trunks are not DID. Nor is DID inherent in dedicated trunks. Dr. Alleman pointed out at the interview that he had made a device in the late 1980's, before the present invention was made, in which a dedicated line from the subscriber to the service center, was used for call-back. Such a device is not economically feasible, because the cost of the dedicated line device, as well as the cost of the dedicated lines far exceed the cost of DID trunks for multiple subscribers. IDT had just such a system

at the time of the New York Times article. The present invention only has a single DID inbound trunk to serve hundreds of subscribers, and a relatively few outbound trunks. The DID initial call is toll-free. IDT had no such system in 1991 or 1992, and none of the articles claims the contrary. The cost savings with DID are substantial for international call back. A line dedicated to a single subscriber costs from \$20 up per month. A DID line costs less than two dollars per subscriber because many subscribers can use a single DID line. It is for that reason that Dr. Alleman stopped using his expensive dedicated line box and changed to the present invention. It is believed that IDT changed from using a dedicated line for each subscriber to DID sometime after the articles in the New York Times and Business Week.

Examiner Zele suggested that clarifying the reference to the New York Times article on page 4 of the specification, together with argument on the merits of the references would be a better approach than arguing about the evidence under Rule 131. No commitment was made by either Examiner Zele or Examiner Matar as to patentability of the invention.

On the question of whether DID is inherent in the New York Times article, Judge Newman of the Federal Circuit recently suggested an analytical technique for determining whether a limitation is inherent in a reference. In her dissenting opinion in *In re Schreiber*, ___ F. 3d___ (No. 97-1201, Fed. Cir. October 23, 1997), she used the classic definition of anticipation: "That which infringes if later anticipates if earlier." She maintained that the claim limitations would not make the cited reference into an infringement if the cited reference were after the patent that might issue on the claimed

invention. The cited reference simply did not have the claimed limitations, so it could not be an infringement. Of course, the rejection of the claims was proper, but not on the ground of anticipation in *Schreiber*. The claims were indefinite in not specifying structural dimensions of an opening that would allow oil to pass through, but not more than a few kernels of popped popcorn. Structure could easily have been recited to satisfy 35 U.S.C. § 112, instead of using functional language. The majority reached the right result, but for the wrong reason. Judge Newman's idea of looking at the prior art as if it were later to see whether it would infringe is a useful tool for analysis.

Applying the legal maxim here, if the IDT system were later than the present invention, and it was charged with being an infringement of proposed claim 23, clearly there could be no infringement, because IDT does not have the "improvement comprising" DID.

At the interview, applicant was urged to specifically recite where the specification supports the language used in the claims. Examiner Matar questioned whether the concept of international call-back, recited in proposed claims submitted before the interview, was supported by the specification. New claim 21 is supported by the specification at page 5, lines 1-2 for economical use of differences in tariff rates, international telephone service for subscribers at page 1, lines 12-14, direct inward dial at page 9, lines 1-9, and call-back at page 10, lines 12-17.

New claim 26 is a method claim defining the invention as a series of steps. New claim 31 is a Jepson claim specifically identifying DID as the key improvement in the

combination for international call-back. All of the other new claims are dependent on the independent apparatus and method claims.

Turning to the Official Action, paragraph 1 relates to a 112 rejection of canceled claims. It is believed that the new claims do not have the problem alluded to in this paragraph.

Paragraph 2 relates to anticipation in view of Kahn. All of the claims now define the invention as including DID, so Kahn cannot be an anticipation. The title to paragraph 2 indicates reliance upon section 103 of the statute, but there is no obviousness rejection based upon Kahn. In any event, Kahn fails to teach DID, so the invention is not obvious in view of Kahn.

Paragraph 3 is a 103 rejection based upon Kahn. However, Kahn fails to teach the use of DID, so there is no basis for an obviousness rejection on this one reference.

Paragraph 4 is a 103 rejection based upon Kahn and Billinger. ANI is not used in the present invention, so Billinger is not applicable. It is believed that the recitation in all claims of DID distinguishes over this combination of references. See also the Declaration of Casner which comments on Kahn and Billinger.

Paragraph 5 is a 103 rejection based upon Kahn in view of Curtin **and/or** Exhibit B. Considering first the rejection based on Kahn and Exhibit B, it is noted that only three of the articles contained in Exhibit B bear dates before the filing date of this application. Those three (New York Times and two Business Week articles) have already been described above with respect to the 131 declarations. Those articles do not make any mention of DID, so they cannot provide the missing DID lacking in Kahn.

Combining Kahn with the three magazine articles fails to teach the claimed invention of DID in international call-back.

As to the rest of Exhibit B, all of the references are dated **after** the effective filing date of the application, so they may not be cited as prior art. Examiner Matar has cited the case of *Gould v. Quigg* for the proposition that references dated after the filing date of an application can be prior art (page 8, footnote 2). This citation is not sound, because there was no 103 rejection on any of the references. The rejection in *Gould* was a lack of enablement under the first paragraph of Section 112. The article was cited only to show "the level of ordinary skill in the art." There is no authority for the proposition that a reference bearing a date **after** the filing date of this application can be relied upon under Section 103. Even if there were an inquiry here into the level of skill in 1992, and there is none, the references bearing dates in 1993 and 1995 cannot possibly reveal the level of skill in 1992. *they do*

Considering the combination of Kahn and Curtin, there is no suggestion or teaching that a manual device for entering one's own telephone number to permit call-back can be combined with DID, which merely identifies a caller to the called party. All Curtin relates to is an apparatus "for identifying who is placing a call to prior to answering" (Abstract of Curtin patent). One who dials in his own number in the Kahn system **knows** who is placing the call to his telephone, so he has no need for DID. Implicit in DID identification is that the call is placed by a third party, not the person dialing in his own number as in Kahn.

Even if the references are combined, there is no suggestion in either Kahn or Curtin of international call-back according to the claimed invention here. The combination is not taught, and even if it were taught, the combination fails to make the claimed invention obvious.

Paragraphs 6, 7 and 8 of the Office Action has already been discussed with respect to the 131 declarations and the shortcomings of the references on the merits.

Paragraph 9 simply dismisses the evidence of commercial success without even considering it, much less disproving it. Applicant has submitted additional declarations of Alleman and Casner under Rule 132. These declarations show the invention is not obvious in view of the prior art, as well as relating to the secondary considerations of commercial success, long felt need, and acquiescence of others. Only the Examiner believes that Dr. Alleman was not the first to invent international call-back with DID. No one, in any of the references cited, including those dated after the filing date of the application, has ever claimed that Dr. Alleman is **not** the original true and first inventor, just as he swore in the original oath in this case. The Examiner must have proof in order to disregard the 132 declarations. Hindsight reconstruction of the prior art is no substitute for evaluating the evidence honestly and carefully.

Paragraph 10 is moot in view of the new claims. The Examiner urges Applicant to "address the limitations in the current claims" (page 22, emphasis present), and the foregoing remarks have done so. At page 24, the Examiner urges the inclusion of the words "international" and "call back," and the new claims use these words.

Paragraph 11 need not be responded to, since it only cites art of interest, but not relied on. None of the references there cited is remotely similar to the claimed invention.

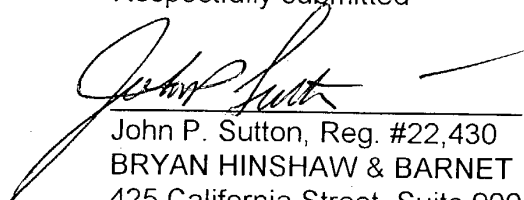
Part B, page 28 is an attempt to record the prosecution history as viewed by the Examiner. No useful purpose is served by arguing about what happened. All applicant wants is a patent of proper scope for his invention. Laying blame should not be the goal of examination. Rather, cooperative effort to obtain the fairest and best protection for the inventor's contribution should be the goal. Any reasonable suggestion toward that end would be greatly appreciated.

Paragraphs 12-14 (page 31) require no response.

Favorable action is solicited.

Respectfully submitted

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